

U.S. Serial No.: 09/482,235
Docket No. 26068-05E

Examiner: Brenda Coleman
Art Unit: 1624

REMARKS

Claims 3-5, 8-11, 13-16, 19-24, and 26-27 are currently pending in this application.
Claim 12 has been cancelled.

Reconsideration and withdrawal of the rejections of all of the claims of the application in view of the amendments made above and the remarks to follow is respectfully requested.

The Examiner asserts that Applicants failed to comment on the 35 U.S.C. 112, first paragraph rejection of claims 1, 3-5, 8-17, and 19-25 which is directed to the definition of X where "X represents S and/or O". Applicants respectfully submit that they did not comment on this rejection because the definition of X where "X represents S and/or O" was contained in claims 1 and 17, which were cancelled in the previous amendment and Applicant did not believe that any comment was required. Claims 26 and 27 as presented in the previous amendment filed on December 29, 2003 contain the recitation that X is O. Support for this recitation is readily discernible from page 81 of the provisional application, as explained on page 9 of the previous response filed by Applicants on December 29, 2003. Therefore, Applicants respectfully request that the rejection of claims 1, 3-5, 8-17, and 19-25 under 35 U.S.C. 112, first paragraph, directed to the definition of X where X represents S and/or O be reconsidered and withdrawn as there are no pending claims that contain this recitation.

The Examiner also asserts that claims 3-5, 8-16, 19-24, and 26-27 are rejected under 35 U.S.C. 112, first paragraph as being indefinite for "reasons of record and stated above." However, it does not appear that there are any other outstanding rejections based on indefiniteness other than the 35 U.S.C. 112, second paragraph rejection mentioned in paragraph 5 of the Office Action. If the Examiner believes otherwise, it is respectfully

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requested that such rejections based on indefiniteness be more clearly explained so that Applicants can address any outstanding issues remaining.

Applicants note with appreciation that the Examiner has withdrawn the rejection based on indefiniteness under 35 U.S.C. 112, second paragraph noted in paragraph 8 of the previous office action except for h). Because Applicants have canceled claim 12 in this amendment, Applicants respectfully request that this rejection also be withdrawn as being moot.

Next, the Examiner maintains the §102 rejections on the grounds that the instant claims are not described "in the applicants priority document" nor are Applicants entitled to the benefit of Provisional application No. 60/002,164 and the August 11, 1995 priority date.

Applicants respectfully disagree. Applicants respectfully submit that all of the conditions for obtaining the benefit of the Provisional Application have been met and that Applicants are thus entitled to claim priority to the Provisional Application. Applicants also respectfully submit that the instant claims are described in each of Applicants' "priority documents." Applicants address each issue in turn.

As set forth in MPEP §201.11, in order for the instant application to obtain the benefit of the filing date of an earlier filed application, the following conditions (among others¹) must be met:

- 1) With respect to claiming benefit under 35 U.S.C. 120, the later filed application must be co-pending with the prior application or with an application similarly entitled to the benefit of the filing date of the prior

¹ MPEP §201.11 also requires that i) the later filed application must be filed by an inventor or inventors named in the previous application; ii) for utility applications filed on or after November 29, 2000, benefit claims under 35 U.S.C. 119(e) or 120 must be made during the pendency of the application and within the time period set forth in 37 C.F.R. 1.78(a)(2) and (a)(5)(ii); and iii) if benefit is being claimed to a provisional application which was filed in a language other than English, certain conditions must be met. The satisfaction of these conditions are not at issue here.

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application and with respect to claiming benefit under 35 U.S.C. 119(e) to the Provisional Application, the nonprovisional application must be filed not later than 12 months after the date on which the Provisional Application was filed;

- 2) The later filed application must be an application for a patent for an invention, which is also disclosed, in the prior application;
- 3) The later filed application must contain a specific reference to the prior application(s) in the specification.

With respect to (1), each application, beginning with the instant application and working backwards, was filed during the co-pendency of its parent application and thus Applicants have established an unbroken chain of co-pendency back to the filing date of the Provisional Application. Therefore, it is respectfully submitted that this condition has been satisfied.

With respect to (2), the instant application, and all of the intervening applications back to the Provisional Application at issue, each specifically contained a statement incorporating by reference the disclosures of all of the earlier filed applications, specifically:

- The instant application, which is a divisional of U.S. Serial No. 09/206,082 (filed December 4, 1998), explicitly states that the disclosure of this parent application is incorporated by reference.
- In turn, parent application Serial No. 09/206,082, which is a continuation-in-part of application Ser. No. 08/817,230 (filed Jun. 4, 1997), explicitly states that the disclosure of the '230 application is fully incorporated by reference.
- Further, grandparent application Serial No. 08/817,230 was the U.S. national phase entry under 35 U.S.C. 371 of PCT/IB96/00987, which itself was a continuation-in-part of U.S. provisional application Serial No. 60/002,164, and this '230 application similarly and explicitly stated that the disclosure of the Provisional Application was fully incorporated by reference.

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Therefore, it is respectfully submitted that this second condition has been satisfied.

Lastly, with respect to (3), the instant application, and all of the earlier filed applications back to the Provisional Application, each specifically reference all of the earlier filed applications.² Thus, it is respectfully submitted that this last condition has been satisfied.

Thus, because the instant application has met all of the conditions for obtaining the benefit of the Provisional Application, Applicants respectfully submit that the instant application is entitled to the benefit of the August 11, 1995 priority date.

Turning to the second grounds of rejection, the Examiner also asserts that the instant claims are not described in Applicants' "priority document" and thus are only entitled to benefit of U.S. Application No. 09/206,082 filed December 4, 1998 and references *In re Scheiber* in support thereof. Applicants respectfully submit that *In re Scheiber* is not dispositive in the present case because *In re Scheiber* does not discuss a situation wherein each of the applications specifically incorporates the disclosure of all of the earlier filed applications by reference.

² The instant application recites that "[t]his application is a divisional of U.S. Serial No. 09/206,082, now Patent No. 6,037,468 filed December 4, 1998, which is a continuation-in-part of co-pending U.S. application Ser. No. 08/817,230, filed Jun. 4, 1997 now abandoned as the U.S. national phase entry under 35 U.S.C. 371 of PCT/IB96/00987, which had an international filing date of Aug. 9, 1996, claiming benefit of U.S. application Ser. No. 60/002,164 filed Aug. 11, 1995, all of which are incorporated herein in their entireties by reference."

In turn, the 09/206,082 application (now U.S. Patent No. 6,037,468) sets forth that it is "a continuation-in-part of co-pending U.S. application Ser. No. 08/817,230, filed Jun. 4, 1997 now abandoned as the U.S. national phase entry under 35 U.S.C. 371 of PCT/IB96/00987, which had an international filing date of Aug. 9, 1996, claiming benefit of U.S. application Ser. No. 60/002,164 filed Aug. 11, 1995, all of which are incorporated herein in their entireties by reference."

The 08/817,230 application is a U.S. national phase entry under 35 U.S.C. 371 of PCT/IB96/00987 and thus is the same application. The PCT/IB96/00987 application (and thus the 08/817,230 application) provide that: "[t]his is a continuation-in-part of U.S. provisional application serial number 60/002,164 filed August 11, 1995, which is incorporated herein by reference."

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As set forth above, the instant application and all of the intervening application back to the Provisional Application explicitly indicates each of the applications as being incorporated by reference in its entirety. Thus each of the applications in the chain of priority from the instant application back to the Provisional Application specifically incorporates the disclosures of all of the earlier filed applications and thus all of the applications, by virtue of the incorporation by reference statement, describe the definition for the instant R.

Because the instant application, as well as each of the intervening applications back to the Provisional Application specifically incorporates by reference all of the disclosures of the earlier filed applications, all of the disclosures contained within the earlier filed applications are thus incorporated into the instant application as if fully set forth therein. Therefore, Applicants respectfully submit that the instant claims are described in each of the intervening applications, including the Provisional Application, and thus are entitled to a filing date of August 11, 1995.

With respect to the rejection of claims 3-5, 8-16, 19-24, and 26-27 under 35 U.S.C. 102(b) as allegedly being anticipated by Wood et al., Tetrahedron Letters, Applicants submit that the foregoing is sufficient to demonstrate that the instant claims are entitled to the benefit of the Provisional Application. Thus, the effective filing date of Applicants' application is 11 August 1995, the date of the Provisional Application. Because Wood et al., Tetrahedron Letters, is dated as of 1996 (and as discussed in the previous response to the office action filed on December 29, 2003), this reference should not be deemed to be available as prior art under 35 U.S.C. § 102(b) and/or (e). Therefore, it is respectfully requested that the rejection of claims 3-5, 8-16, 19-24, and 26-27 under 35 U.S.C. 102(b) as allegedly being anticipated by Wood et al., Tetrahedron Letters be withdrawn.

Likewise, with respect to the rejection of claims 3-5, 8-16, 19-24, and 26-27 under 35 U.S.C. 102(b) as allegedly being anticipated by Wood et al., Journal of American Chemical Society, the cited reference is dated October 18, 1995 and thus should also not

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be available as prior art under 35 U.S.C. § 102(b) and/or (e) for the reasons noted above. Reconsideration and withdrawal of the rejection of claims 3-5, 8-16, 19-24, and 26-27 is respectfully requested.

The Examiner has also rejected claims 26 and 27 under 35 U.S.C. 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner further asserts that Applicant is required to cancel the new matter in the reply to the office action.

As discussed above, Applicants respectfully submit that the instant application, as well as each of the earlier filed applications back to the Provisional Application, specifically incorporate by reference all of the earlier filed applications. As set forth in M.P.E.P. §608.01(p), the inclusion of an incorporation by reference statement in a later-filed application permits Applicants to include subject matter from the prior application into the later-filed application without the subject matter being considered as new matter. Therefore, the present application does not contain any new matter as all of the limitations of claims 26 and 27 have been incorporated by reference into the instant application. A discussion of the support for all of the limitations of these claims was presented in the previous response filed on December 29, 2003. Applicants respectfully request that the rejection of claims 26 and 27 under 35 U.S.C. 112, first paragraph as containing subject matter that was not described in the specification be reconsidered and withdrawn.

CONCLUSION

Applicant believes that the foregoing is a full and complete response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejection of all of the claims is requested. Applicants believe that claims 3-5, 8-11, 13-16, and 26-27 are now in condition for allowance and an indication of allowability and an early Notice of Allowance is respectfully requested.

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If Examiner feels that a telephonic interview would be helpful, she is requested to call the undersigned at (203) 575-2648.

Respectfully submitted,


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